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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,942	03/25/2004	Gerald L. Thompson	7330	6876

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EXAMINER	
BRUENJES, CHRISTOPHER P	
ART UNIT	PAPER NUMBER
1772	

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/808,942	THOMPSON ET AL.	
	Examiner	Art Unit	
	Christopher P. Bruenjes	1772	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-22 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 1-22 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 21 June 2004 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5 and 8-12 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 37 of copending Application No. 10/801,734. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim

37 of application number 10/801,734 teach a faced building insulation assembly comprising an insulation layer having a length, width and thickness and a first and second major surface. The insulation assembly further comprises a facing formed by a Kraft paper sheet material having a central field portion bonded to the insulation layer by an asphalt coating layer that contains an essential plant oil odor-reducing additive in an amount approximating 1 part by weight odor-reducing additive to 10,000 parts asphalt blend and a fungi growth inhibiting agent to render the Kraft paper sheet fungi growth resistant.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-3, 6-10, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstein et al (US 2001/0030018 A1) in view of Gembala (US 2004/0166087 A1).

Regarding claims 1-3 and 8-10, Weinstein et al teach a faced fibrous insulation assembly comprising a fibrous insulation blanket having a length, a width, a thickness, and first and second major surfaces defined by the length and width of the blanket (see claim 1 on page 10). The faced fibrous insulation assembly further comprises a facing comprising a Kraft paper sheet material having a central field portion, in which the central field portion has an outer major surface and an inner major surface for bonding to a major surface of a fibrous insulation blanket and is bonded to the fibrous insulation blanket by coating the inner major surface of the

central field portion with an asphalt coating layer (p.5, paragraph 43).

Weinstein et al fail to teach the asphalt coating layer containing an odor-reducing additive. However, Gembala teaches that the need for odor reduction and masking in the asphalt compositions is well known in the construction industry (p.1, paragraph 4). Gembala further teaches that essential plant oil odor-reducing additives are added to asphalt in order to reduce and mask the odor of the asphalt composition (p.1, paragraph 7). Gembala also teaches that the fragrance is added in moderate amounts so as to not interfere with the performance or workability of the asphalt (p.1, Paragraph 7). Therefore, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add an essential plant oil odor-reducing additive to a asphalt used in the art of roofing materials in order to reduce and mask the odor of the asphalt composition, as taught by Gembala, and that the amount of the additive would be optimized based on the amount needed to reduce and mask the odor without interfering with the performance of the asphalt, as taught by Gembala.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add an essential plant oil odor-reducing additive in the amount

claimed to the asphalt containing sheet material of Voigt et al and Szwarc in order to reduce and mask the odor of the asphalt composition as desired in the construction industry, as taught by Gembala. Furthermore, the amount of the additive would be selected by one having ordinary skill in the art after routine experimentation to determine the optimal amount desired to mask the odor without interfering with the performance or workability of the asphalt, as taught by Gembala.

Regarding claims 6-7 and 13-14, Weinstein et al teach that the Kraft paper sheet material includes a foil layer, a scrim layer and a Kraft paper layer (p.5, paragraph 43).

6. Claims 4-5 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstein et al and Gembala as applied to claims 1-2 and 8-9 above, and further in view of Szwarc (USPN 2,496,566).

Weinstein et al and Gembala taken as a whole teach all that is claimed in claims 1-2 and 8-9 as presented above, but fail to teach that the Kraft paper sheet material with the asphalt coating layer is fungi growth resistant. However, Szwarc teaches asphalt used to form water-vapor resistant Kraft paper, such as the Kraft paper sheet of Weinstein et al, contains a fungicide in an amount sufficient to render the sheet material

fungi growth resistant (col.1, l.18-20 and col.2, l.6-11). Therefore, it would have been obvious to one having ordinary skill in the art that fungicides are added to asphalt coating used to form water-vapor resistant coated Kraft paper in order to render the paper sheet material fungi growth resistant, as taught by Szwarc.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add a fungicide to the asphalt coating of Weinstein et al and Gembala in order to render the Kraft paper sheet material fungi growth resistant, as taught by Szwarc, since one of ordinary skill in the art recognizes that fungi growth resistance is useful for water vapor resistant coated papers, as suggested by Szwarc.

7. Claims 15-18 and 21-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstein et al and Gembala as applied to claim 8 above, and further in view of Trabbold et al (US 2004/0163724 A1).

Weinstein et al and Gembala combined teach all that is claimed in claim 8 as presented above, but fail to teach using an odorless binder such as acrylic when forming the fibrous insulation blanket. However, Trabbold et al teach that it is

well known in the art of glass fiber insulation blankets to use a phenolic powder resin containing formaldehyde as a binder to bond together the glass fibers (p.1, paragraph 7). Weinstein et al teach an example of this traditional binder when forming the insulation blanket, but also teach that other suitable bonding materials may be used (p.3, paragraph 32). Trabbold et al goes on to teach that although there is no health risk with the traditional fiber class using formaldehyde containing binders, formaldehyde at higher levels may cause skin irritation and sensitivity. Therefore, in consideration of such concerns, manufacturers of insulation products have started to offer formaldehyde-free products to provide the consumers an alternative to the traditional insulation products (p.1, paragraph 7). Trabbold et al teach that the currently used formaldehyde free binder used in glass fiber insulation is an acrylic thermosetting binder (p.1, paragraph 8). Note that acrylic thermosetting binders are inherently substantially odorless. Therefore, one of ordinary skill in the art would have recognized that acrylic thermosetting binders, which are odorless, are substituted for formaldehyde binders in the formation of glass fiber insulation, since consumers are concerned with the skin irritation and sensitivity caused by

higher levels of formaldehyde containing binders, as taught by Trabbold et al.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to substitute an acrylic thermosetting binder, which is odorless since it is a known formaldehyde free insulation, as taught by Trabbold et al, for the formaldehyde containing binder used in the glass fiber insulation blanket of Weinstein et al, in order to provide a glass fiber insulation blanket that is formaldehyde free, since consumers are concerned about skin irritation and sensitivity caused by high levels of formaldehyde, as taught by Trabbold et al.

Regarding claims 17-18, Gembala teach that the odor-reducing additive is essential plant oil and the amount of the additive would be selected by one having ordinary skill in the art after routine experimentation to determine the optimal amount desired to mask the odor without interfering with the performance or workability of the asphalt, as taught by Gembala.

Regarding claims 21-22, Weinstein et al teach that the Kraft paper sheet material includes a foil layer, a scrim layer, and a Kraft paper layer (p.5, paragraph 43).

8. Claims 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weinstein et al, Gembala, and Trabbold et al as applied to claim 15 above, and further in view of Szwarc (USPN 2,496,566).

Weinstein et al, Gembala, and Trabbold et al taken as a whole teach all that is claimed in claim 15 as presented above, but fail to teach that the Kraft paper sheet material with the asphalt coating layer is fungi growth resistant. However, Szwarc teaches asphalt used to form water-vapor resistant Kraft paper, such as the Kraft paper sheet of Weinstein et al, contains a fungicide in an amount sufficient to render the sheet material fungi growth resistant (col.1, l.18-20 and col.2, l.6-11). Therefore, it would have been obvious to one having ordinary skill in the art that fungicides are added to asphalt coating used to form water-vapor resistant coated Kraft paper in order to render the paper sheet material fungi growth resistant, as taught by Szwarc.

Thus, it would have been obvious to one having ordinary skill in the art at the time Applicant's invention was made to add a fungicide to the asphalt coating of Weinstein et al and Gembala in order to render the Kraft paper sheet material fungi growth resistant, as taught by Szwarc, since one of ordinary skill in the art recognizes that fungi growth resistance is

useful for water vapor resistant coated papers, as suggested by Szwarc.

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Voigt et al (USPN 2,280,460); Gaston et al (USPN 3,222,243); Toas et al (US 2005/0170721 A1).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher P. Bruenjes whose telephone number is 571-272-1489. The examiner can normally be reached on Monday thru Friday from 8:00am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571-272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Christopher P Bruenjes
Examiner
Art Unit 1772

CPB CPB
May 9, 2006

HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

5/9/06